REMARKS/ARGUMENTS

In the Office Action mailed April 22, 2009 (hereinafter, "Office Action"), claims 1-9, 11-16, 18-24, 32 and 35-36 were rejected under 35 U.S.C. § 103(a). By this paper, claims 1, 4, 6-8, 13-15, 22-24, 32, 35 and 36 are being amended. Claims 12, 20 and 21 are being canceled. Claims 45-47 are being added.

Applicant respectfully responds to the Office Action.

I.   **Claims 1-3, 8-9, 11, 14-16, 18-19, 23, 32 and 35-36 Rejected Under 35 U.S.C. § 103(a)**

Claims 1-3, 8-9, 11, 14-16, 18-19, 23, 32 and 35-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over International Patent Application Publication No. WO 01/63960 to Raith (hereinafter, "Raith") in view of U.S. Patent No. 6,507,740 to Shi (hereinafter, "Shi") in view of U.S. Patent No. 6,141,565 to Feuerstein et al. (hereinafter, "Feuerstein"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)).

By this paper, claim 1 is being amended to recite that "the set of optimum parameters includes a set of optimum system-access parameters that are used when a mobile unit comprising the third transceiver is operating in a system access state." Thus, amended claim 1 requires "determin[ing] ... a set of optimum system-access parameters" "based on a current position of the third transceiver." Support for the amendments that are being made to claim 1 may be found in paragraphs [0006], [0011], and [0029] of Applicant's specification, as well as original claim 4.

Applicant respectfully submits that none of the cited references teaches or suggests "determin[ing] ... a set of optimum system-access parameters" – which are "used when a mobile unit comprising the third transceiver is operating in a system access state" – "based on a current position of the third transceiver," as required by amended claim 1.

The Examiner has previously acknowledged that "R[a]ith in view of Shi ... does not specifically teach ... determining optimum system access parameters...." (Examiner's Answer, dated December 13, 2007, page 6.) However, the current Office Action asserts that "determining optimum system access parameters" is taught by Feuerstein." (Office Action, page 5.) Applicant respectfully disagrees.

Feuerstein relates generally to "providing network parameters to various network elements in a ... wireless communication network in order to optimize operation of the network." (Feuerstein, abstract.) Feuerstein refers to "parameters optimized for particular network conditions." (Id.) Although Feuerstein refers to parameter optimization generally, Feuerstein does not teach or suggest "optimum *system-access* parameters" (i.e., "parameters that are used when a mobile unit comprising the third transceiver is operating in a system access state") as required by amended claim 1.

Feuerstein gives the following examples of "network parameters" that may be "optimized": "communication thresholds, e.g., a threshold at which a signal strength handoff might be requested" (Feuerstein, col. 1, lines 40-42); "network timing information, such as search windows" (Feuerstein, col. 1, lines 43-44); "individual cell, sector or beam traffic density, or related capacity parameters" (Feuerstein, col. 1, lines 47-48); "neighboring cell lists" (Feuerstein, col. 1, lines 48-49); "antenna sector/beam lists" (Feuerstein, col. 1, line 50); "transmit power to utilize for a particular beam, sector or cell" (Feuerstein, col. 2, lines 62-63); "a cell site's receive sensitivity for a particular beam, sector or cell" (Feuerstein, col. 2, lines 64-65); "power control parameters such as thresholds, target settings, operating ranges and the like" (Feuerstein, col. 2, lines 65-67); "information with respect to grade of service (GOS), metrics, i.e., bit error rate (BER), frame error rate (FER), voice quality measurements, data throughput, packet success probabilities, dropped call rates, call origination and/or termination success rates, or the like" (Feuerstein, col. 3, lines 1-6); "identification of particular beams or signals, associated with particular base stations, to monitor or transmit in order for the mobile to determine the appropriate resources to utilize in a handoff situation" (Feuerstein, col. 3, lines 9-13); and "drop timers" (Feuerstein, col. 4, line 46).

However, none of Feuerstein's examples of "network parameters" that may be "optimized" are "*system-access* parameters" (i.e., "parameters that are used when a mobile unit comprising the third transceiver is operating in a system access state") as in claim 1. Even though Feuerstein refers to parameter optimization generally, Feuerstein does not teach or

suggest "determin[ing] ... optimum *system-access* parameters," as required by amended claim 1. Accordingly, Feuerstein does not make up for the deficiencies of Raith and Shi. Thus, even if Raith, Shi and Feuerstein were combined in the manner proposed in the Office Action, the resulting combination still would not teach or suggest all of the subject matter of amended claim 1.

For at least the foregoing reasons, Applicant respectfully submits that amended claim 1 is allowable. Claims 2-3 depend from claim 1, and are therefore allowable for at least the same reasons.

Claim 8 is being amended to recite "receiv[ing] a set of optimum system-access parameters," which are "used when the mobile unit is operating in a system access state," and which are "determined based on a current position of the mobile unit." As discussed above, the cited references do not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 8 is allowable. Claims 9 and 11 depend from claim 8, and are therefore allowable for at least the same reasons.

Claim 14 is being amended to recite "transmit[ting] a set of optimum system-access parameters," which "are used when the mobile unit is operating in a system access state," and which are "determined based on a current position of [the] mobile unit." As discussed above, the cited references do not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 14 is allowable.

Claim 15 is being amended to recite "transmit[ting] ... a set of optimum system-access parameters," which are used "when the mobile unit is operating in a system access state," and which are "determined based on a current position of the mobile unit." As discussed above, the cited references do not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 15 is allowable. Claims 16 and 18-19 depend from claim 15, and are therefore allowable for at least the same reasons.

Claim 23 is being amended to recite "determining ... a set of optimum system-access parameters" - i.e., parameters that "are used when the mobile unit is operating in a system access state" - "based on the current position of the mobile unit." As discussed above, the cited references do not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 23 is allowable.

Claim 32 is being amended to recite "determining ... a set of optimum system-access parameters" - i.e., parameters that "are used when the mobile unit is operating in a system access

state" - "based on the current position of the mobile unit." As discussed above, the cited references do not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 32 is allowable.

Claim 35 is being amended to recite "determining ... a set of optimum system-access parameters" - i.e., parameters that "are used when the mobile unit is operating in a system access state" - "based on the current position of the mobile unit." As discussed above, the cited references do not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 35 is allowable.

Claim 36 is being amended to recite "determining ... a set of optimum system-access parameters" - i.e., parameters that "are used when the mobile unit is operating in a system access state" - "based on the current position of the mobile unit." As discussed above, the cited references do not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that claim 36 is allowable.

II.   Claims 4-6, 12-13, 19-22 and 24 Rejected Under 35 U.S.C. § 103(a)

Claims 4-6, 12-13, 19-22 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Raith in view of Shi and Feuerstein and in further view of U.S. Patent No. 6,934,546 to Corbett et al. (hereinafter, "Corbett").

Claims 4-6 depend from claim 1. As discussed above, Applicant respectfully submits that claim 1 is allowable. Accordingly, Applicant respectfully submits that claims 4-6 are allowable for at least the same reasons.

Claim 12 is being canceled.

Claim 13 depends from claim 8. As discussed above, Applicant respectfully submits that claim 8 is allowable. Accordingly, Applicant respectfully submits that claim 13 is allowable for at least the same reasons.

Claims 19 and 22 depend from claim 15. As discussed above, Applicant respectfully submits that claim 15 is allowable. Accordingly, Applicant respectfully submits that claims 19 and 22 are allowable for at least the same reasons.

Claims 20 and 21 are being canceled.

Claim 24 depends from claim 23. As discussed above, Applicant respectfully submits that claim 23 is allowable. Accordingly, Applicant respectfully submits that claim 24 is allowable for at least the same reasons.

III. Claims 7 and 14 Rejected Under 35 U.S.C. § 103(a)

Claims 7 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Raith in view of Shi and in further view of U.S. Patent Application Publication No. 2002/0077103 to Bonta (hereinafter, "Bonta"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

Claim 7 is being amended to recite "receiv[ing] a set of optimum system-access parameters," which "are used when the mobile unit is operating in a system access state," and which are "determined based on a current position of the mobile unit." Applicant respectfully submits that the cited references do not teach or suggest this claimed subject matter.

The Office Action asserts that "Raith discloses .... receiv[ing] [a] set of optimum system access parameters." (Office Action, page 6.) In particular, the Office Action states that "this is implied as the reference teaches using position of mobile communicate device to optimize seamless handovers." (Id.) Applicant respectfully disagrees. Although Raith refers to using "the location of the mobile terminal ... to optimize handovers" (Raith, page 4, lines 2-4), this does not teach or suggest "*system-access* parameters," as required by claim 7 (emphasis added). In fact, as indicated above, the Examiner has previously acknowledged that "R[a]ith in view of Shi ... does not specifically teach .... determining optimum system access parameters...." (Examiner's Answer, dated December 13, 2007, page 6.)

Bonta does not make up for the deficiencies of Raith and Shi. Bonta does not teach or suggest "system-access parameters." Bonta refers to "system control parameters." (Bonta, paragraph [0016].) However, the "system control parameters" of Bonta are not the same as the "system-access parameters" in claim 1. Bonta provides the following examples of "system control parameters": "a neighbor list of handoff candidates, a handover timer, a handover threshold, ... a power control threshold." (Bonta, paragraph [0016].) However, none of Bonta's examples of "system control parameters" are "system-*access* parameters" (i.e., "parameters that are used when the mobile unit is operating in a system access state") as in amended claim 7.

Thus, even if Raith, Shi and Bonta were combined in the manner proposed in the Office Action, the resulting combination still would not teach or suggest all of the subject matter of amended claim 7. Accordingly, Applicant respectfully submits that amended claim 7 is allowable.

Claim 14 is being amended to recite "transmit[ting] a set of optimum system-access parameters," which "are used when the mobile unit is operating in a system access state," and which are "determined based on a current position of [the] mobile unit." As discussed above, the cited references do not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that amended claim 14 is allowable.

IV. New Claims

New claim 45 is being added. New claim 45 depends from claim 24. New claim 45 is supported by at least paragraph [0080] of Applicant's specification. Applicant respectfully submits that the cited references do not teach or suggest "transmitting the set of optimum system-access parameters and the set of optimum soft-handoff parameters to the mobile unit in an in-traffic system parameters message," as recited in new claim 45.

New claim 46 is also being added. New claim 46 also depends from claim 24. New claim 46 is supported by at least paragraph [0078] of Applicant's specification. Applicant respectfully submits that the cited references do not teach or suggest "determining the set of optimum system-access parameters and the set of optimum soft-handoff parameters when the mobile unit moves into a new coverage area," as recited in new claim 46.

New claim 47 is also being added. New claim 47 depends from claim 46. New claim 47 is supported by at least paragraph [0036] of Applicant's specification. Applicant respectfully submits that the cited references do not teach or suggest "a position database that stores position information about various coverage areas, and that also stores optimum system-access and soft-handoff parameters associated with each coverage area," as recited in new claim 47.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that all pending claims in the present application are in a condition for allowance, which is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated: July 15, 2009

By: _____
Kam T. Tam, Reg. No. 35,756
(858) 651-5563

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121
Facsimile: (858) 658-2502